

III. REMARKS/ARGUMENTS

A. Status of the Claims

Claims 1, 4, 6-69, and 71 are pending. Applicants have canceled claims 2, 3, 5, and 70 without prejudice. Applicants have amended claims 1, 4, 24, 29, 32, 43, 57 and 71. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

B. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 4, 6-69, and 71 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 6,088,686 to Walker et al. (“Walker”) in view of the publication “Online Business Computer Applications” by Eliason (“Eliason”). Specifically, with regard to independent claims 1, 32, 43 and 57,¹ the Office Action asserts that Walker discloses all the elements of these claims with the exception of “automation through a web site.” Office Action, Page 3. To address this deficiency, the Office Action cites Eliason, which allegedly discloses “automation through a web site.” Id. Thus, because it is allegedly “clear that one would be motivated because of greater efficiency,” the Office Action contends that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Automation through a website as taught in Eliason to Walker.” Id. Applicants respectfully disagree, as the Office Action has failed to establish a prima facie case of obviousness.

¹ Although the Office Action states that claims 1-71 are rejected, the Office Action has not set forth a rejection for claims 70 and 71.

In order to establish a prima facie case of obviousness, at least three criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Notably, “the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant’s disclosure.” MPEP 2142 (discussing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991)). Second, there must be a reasonable expectation of success. Finally, the combined or modified references must teach or suggest all claim limitations. See MPEP 2142 et seq.

There is no evidence of motivation to modify Walker with the alleged “automation through a web site” disclosure of Eliason. The only alleged motivation to make the proposed combination is the Office Action’s conclusory and unsupported statement that the combination of these two references would lead to “greater efficiency.” Nothing in the references themselves, however, provides this alleged motivation, nor has the Office Action identified a source of this motivation. If the Office Action is taking Official Notice of this alleged motivation, Applicants respectfully traverse this taking of Official Notice.

Based on its disclosure, Walker actually teaches away from the proposed combination. Walker discloses a Local Branch Representative that interfaces between the credit applicant and the financial systems. The Local Branch representative receives identification during a sales session with the credit applicant. Walker, Col. 6, ll. 55-58; Fig 1. The Local Branch Representative not only enters the information but receives status rankings so that the Local Branch Representative can take a “particular direction” during a sales session. Walker, Col. 6, ll. 52-58. Thus, even though some automation exists, primarily to the customer’s qualifications, Walker clearly requires a person in order to receive identification information from, and provide financial offers to, the customer.

Fully automating Walker would make it unsuitable for its intended use. MPEP 2143.01 (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984))).

The proposed combination appears to be the result of impermissible hindsight, something that the Federal Circuit has repeatedly cautioned against. See In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (“The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.”); see also In re Lee, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Jones, 958 F.2d 347 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, as there is no evidence of motivation for the proposed combination, Applicants respectfully request that this rejection be withdrawn.

Even assuming that there is motivation to combine Walker and Eliason, the proposed combination fails to disclose or suggest all claim limitations.

Specifically, independent claim 1 recites:

1. A method of offering a financial product to a customer, the method comprising:
receiving identification information regarding the customer from a web site over a network connection, the identification information provided by the customer to the web site while the customer is conducting an on-line transaction on the web site;
retrieving data related to the identification information;
determining if the customer qualifies to receive an offer of the financial product in response to the retrieved data;

relaying information for the offer of the financial product to the web site over the network connection if the customer qualifies; and offering the financial product to the customer through the web site, wherein the acts of receiving, retrieving, determining and relaying occur in real-time.

Appl'n, Claim 1 (emphasis added). As evidenced by the emphasized text, claim 1 requires that the identification information is provided by the customer while the customer is conducting an on-line transaction on the web site, and the offer is made to the customer through the website. Independent claims 32, 43, 57 and 71 claim a similar limitation.

Walker does not disclose that the identification information “is provided by the customer to the web site while the customer is conducting an on-line transaction on the web site.” Rather, as discussed above, Walker discloses that the identification information is provided to the Local Branch Representative. See Fig. 1. Walker's Local Branch Representative is the human interface between the customer and Walker's credit processing system, see Fig. 1, and not only enters the information into Walker's system, but also conveys the credit evaluation status to the customer by making an offer to the credit applicant. Walker, Col. 6, ll. 52-55. Thus, unlike the claimed invention, the customer does not provide identification information to a web site, nor is the customer provided with the offer through the web site..

The present invention is not simply an automation of Walker's disclosure, which appears to be the reason that the Office Action has cited Eliason for “automation through a web site.” Instead, among other things, the present invention eliminates the interface of Walker's Local Branch Representative entirely. Instead, the customer, while conducting a transaction on a website, provides identification directly to a website, and receives an offer directly through

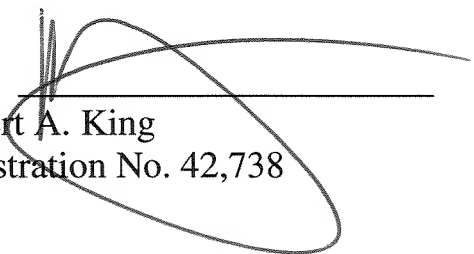
the website. Even as modified, Walker's Local Branch Representative is still involved in at least the information collection and offering steps. Therefore, because the proposed combination of references fails to disclose or suggest all claim limitations, Applicants respectfully request that this rejection be withdrawn.

IV. CONCLUSION

Applicants respectfully submit that the application is in condition for allowance. In the event the Patent and Trademark Office requires any additional fees, please charge such fees, including fees for any extensions of time, to the undersigned's Deposit Account No. 50-0206. Should any outstanding issues remain, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,
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Dated: January 23, 2007

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